

Remarks

The final Office Action dated September 25, 2009, notes the following new grounds of rejection: claims 1-11 stand rejected under 35 U.S.C. § 103(a) over Cato (U.S. Patent No. 5,539,394) in view of Pavesi (U.S. Patent No. 6,549,536). The drawings are objected to, and corrected drawing sheets are required. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 103(a) rejection because the cited combination of references lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, *e.g.*, generating a hash value in a transponder, the hash value identifying a part of a distinguishing dataset that is stored in a transponder, and using the hash value to access the part of the distinguishing dataset. Because neither reference teaches these aspects, no reasonable combination of these references can provide correspondence to the claimed invention. As such, the § 103 rejection fails.

More specifically, the cited hashing number of the ‘394 reference does not correspond to Applicant’s hash value, which is used to access a part of the distinguishing dataset (*e.g.*, a serial number) with the accessed part then being used to calculate a transmission parameter (*e.g.*, a time slot). Instead, the hashing number of the ‘394 reference that is calculated in the tag (using the hashing base number) is the time slot in which the tag will transmit. *See, e.g.*, Col. 5:29-55. As such, the hashing number of the ‘394 reference does not identify a part of the distinguishing dataset that is stored in the tag and the hashing number of the ‘394 reference is not used to access a part of such a distinguishing dataset, as in the claimed invention. Thus, the ‘394 reference does not teach generating a hash value in the transponder, using the generated hash value to access a part of the distinguishing dataset stored in the transponder, and then using the accessed part to determine the time slot, as claimed. Instead, the ‘394 reference divides the tag’s serial number by the hashing base number (provided by the reader) to determine the hashing number which corresponds to the time slot in which the tag will transmit its serial number to the reader. *See, e.g.*, Col. 5:48-55. Applicant submits that the cited portions of the ‘536 reference fail to address the above discussed shortcomings of the

‘394 reference. In particular, the ‘536 reference does not teach generating a hash value in a transponder (as claimed) and, in fact, the ‘536 reference fails to make any mention of a transponder. *See, e.g.*, Col. 3:41-44. Thus, no reasonable combination of these references can provide correspondence to the claimed invention.

In the previous response, Applicant explained in detail how the hashing number of the ‘394 reference is unrelated to Applicant’s generated hash value. In the instant Office Action, the Examiner apparently continues to rely upon the hashing number of the ‘394 reference while failing to respond to Applicant’s previous arguments regarding the clear lack of correspondence. The Examiner’s new reliance upon the ‘536 reference does not relieve the Examiner of the obligation of responding to the substance of Applicant’s previous arguments, particularly in situations (such as here) where the Examiner continues to rely upon the same portions of the primary reference. *See, e.g.*, M.P.E.P. § 707.07(f).

Moreover, the ‘536 reference appears to be entirely unrelated to the ‘394 reference and the claimed invention. As such, it is unclear to Applicant how the Examiner is proposing to combine the unrelated teaching of the cited references. For example, the ‘536 reference fails to make any mention of the tags 10 taught by the ‘394 reference or of using a computed hash value to look up an identifier stored in the apparently nonexistent tags. Instead, the ‘536 reference teaches that an IP router computes a hash value from an incoming identifier, the hash value pointing to a hash table that corresponds to one or more outgoing identifiers for devices attached to the router. *See, e.g.*, Col. 3:4-52. In this context, the hash value of the ‘536 reference is not generated in a tag, the hash value does not identify any data stored in the tag, the hash value is not used to access data stored in the tag, and the hash value is not used in any manner to compute a time slot in which the tag communicates with a reader. Applicant submits that the ‘536 reference’s teachings relating to an IP router are entirely inapplicable to the tags 10 of the ‘394 reference. As such, the Examiner’s combination would necessarily involve (extensively) modifying the cited teachings of the ‘536 reference to somehow be applied to the tags 10 of the ‘394 reference. Accordingly, the Examiner’s assertion of such a vague “articulated reasoning” (*e.g.*, “to reduce the chance of collision”) in support of the modification is insufficient. *KSR* and M.P.E.P. § 2141

make it clear that such assertions are inapplicable where the operation of one of the references is modified. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). For example, according to M.P.E.P. § 2141, Applicant can rebut such assertions of obviousness simply by showing that “the elements in combination do not merely perform the function that each element performs separately.” This is also consistent with various parts of *KSR*, which repeatedly refer to combined teachings in which the cited references are not modified in their operation. As such, in the context of *KSR*, the asserted combination “as a whole” is entirely unpredictable based on the asserted teachings of the ‘394 and ‘536 references.

In view of the above, the § 103(a) rejection of claims 1-11 is improper and Applicant requests that it be withdrawn.

Regarding the Examiner’s request that Applicant amend the drawings to include a random number generator, Applicant respectfully declines. As was previously explained to the Examiner, the objection to the drawings relies upon an improper interpretation of the U.S.P.T.O. rules. Specifically, the Examiner erroneously asserts that the drawings “must show every prominent attribute or aspects of the claimed subject matter.” Although the Examiner fails to provide any support for this assertion, it appears that the objection is based on 37 C.F.R. § 1.83(a), which is directed to showing claimed features in the figures. In this instance, the specific aspects identified as missing (*e.g.*, a random number generator), while possibly relevant, are not prominent attributes or aspects. Rather than limit the cited rule to prominent aspects of the claims, the Examiner appears to take the position that the figures must provide a near word-for-word correspondence to the claims. The Examiner’s position, if applied to all cases, would ostensibly require that every patent application contain a near word-for-word replication of all language from the claims into the figures. Moreover, Applicant’s position is also supported by a number of U.S. laws, U.S.P.T.O. rules and passages of the M.P.E.P. This support is largely inconsistent with the Office Action’s position and will be discussed hereafter.

The Examiner’s apparent interpretation of 37 CFR § 1.83(a) is contrary to the U.S.P.T.O. practice, U.S. law and the M.P.E.P. In support of Applicant’s position reference is made to 35 USC § 113 and M.P.E.P. § 601.01(f), which indicate that “applicant shall furnish a drawing where necessary for the understanding of the subject

matter sought to be patented.” The authority for the U.S.P.T.O. to create rules such as 37 C.F.R. § 1.83(a) is derived from 35 USC § 113. Accordingly, 37 C.F.R. § 1.83(a) must be interpreted in light of this law to ensure that the U.S.P.T.O. does not exceed the statutory authority granted by the U.S. Congress. Moreover, M.P.E.P. § 608.02(e) clarifies how 37 C.F.R. § 1.83(a) should be interpreted and applied by an examiner: “The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail *that is essential for a proper understanding of the disclosed invention* should be shown in the drawing.” (*emphasis added*). This language is the suggested paragraph for an examiner that wishes to use a 37 C.F.R. § 1.83(a) objection. The Examiner has not used this language, choosing instead to ignore the second half of the suggested language. In addition, M.P.E.P. § 601.01(f) indicates that it has been U.S.P.T.O. practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC § 113.

Referring now to the claim language at issue, Applicant submits that the random number generator recited in claims 5 and 10 is not a prominent aspect of these claims and, thus, need not be shown in Figure 1. Moreover, Applicant submits that it is not essential for a proper understanding of the disclosed invention that a random number generator be shown in Figure 1 because such aspects would be clearly understood by a skilled artisan. Accordingly, the objection to the drawing is improper and must be withdrawn. In the event that the Examiner chooses to maintain the objection, Applicant submits that the Examiner must provide an adequate explanation regarding why illustration of a random number generator in Figure 1 is essential for a proper understanding of the disclosed invention by one of skill in the art.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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